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From: Jerome W. Massie	Date: April 14, 2004	No. of Pages: ___ 6 (including this page)	Application No.: 09/504,782

Comments: ATTENTION: Mr. Wong

Pursuant to our discussion today, please find attached a REQUEST TO WITHDRAW THE NOTICE OF ALLOWABILITY DUE TO MISCOMMUNICATION. If necessary, please feel free to contact me regarding the withdrawal of the improperly mailed Notice of Allowability/Examiner's Amendment of February 3, 2004.

Your prompt attention to this matter is greatly appreciated.

Jerome W. Massie
Reg. No. 48,118
(202) 585-8219

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, or being facsimile transmitted to the USPTO at (571) 273-1834, on April 14, 2004.

/Angelique Graham

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CONFIRMATION: DATE SENT _____ TIME _____ BY _____

From: Jerome W. Massie	Date: April 14, 2004	No. of Pages: ___ 6 (including this page)	Client/Matter: 740819-337
User #: 2039	Ext: 8219	Disbursement Amount: $	

Docket No. 740819-337

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICE

In re Patent Application of:	)	
Masahiro KUME et al.	)	Group Art Unit: 2828
Serial No. 09/504,782	)	
Filed: February 15, 2000	)	Examiner: Delma R. FLORES RUIZ
For: SEMICONDUCTOR LASER DEVICE, OPTICAL DEVICE APPARATUS AND OPTICAL INTEGRATED UNIT	)	**ATTENTION: Supervisory Patent Examiner Don Wong**

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Angelique Graham

REQUEST TO WITHDRAW THE NOTICE OF ALLOWABILITY

DUE TO MISCOMMUNICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

It is respectfully requested that the Notice of Allowability of February 3, 2004 be withdrawn as inappropriate since the Applicants and the Applicants' representative did not agree to the Examiner's Amendment amending claims 1 and 4 during the telephone conference of January 20, 2004.

On January 15, 2004, Examiner Flores Ruiz telephoned the Applicants' representative, Mr. Jerome Massie, to request that certain amendments to the claims be made to place the application into condition for allowance. That is, besides canceling non-elected claims 7-30, Examiner Flores Ruiz suggested changes to

pending claims 1 and 4. Specifically, Examiner Flores Ruiz dictated the last "wherein" clause of claim 1 as follows:

> a first cladding layer, which is made of a nitride semiconductor of a first conductivity type and is formed over a substrate;
>
> an active layer, which is made of $In_yGa_{1-y}N$ and is formed over the first cladding layer;
>
> a second cladding layer, which is made of still another nitride semiconductor of a second conductivity type and is formed over the active layer; and
>
> an $In_xGa_{1-x}N$ layer of the first conductivity type is formed between the substrate and the first cladding layer,
>
> wherein $0 < x < 1$, $0 < y < 1$ and $x \geq y$ in the composition of In, and
>
> wherein the device further includes a spontaneous emission absorbing layer which is made of another nitride semiconductor of the first conductivity type and an energy cap as an absorbing spontaneous emission layer for emission from the active layer.

and a similar "wherein" clause for claim 4 as follows:

> A semiconductor laser device comprising:
>
> a first cladding layer, which is made of a nitride semiconductor of a first conductivity type and is formed over a substrate;
>
> an active layer, which is made of $In_yGa_{1-y}N$ and is formed over the first cladding layer;
>
> a second cladding layer, which is made of still another nitride semiconductor of a second conductivity type and is formed over the active layer;
>
> an electrode formed over the second cladding layer; and
>
> an $In_xGa_{1-x}N$ layer of the second conductivity type is formed between the second cladding layer and the electrode, and
>
> wherein $0 < x < 1$, $0 < y < 1$ and $x \geq y$ in the composition of In, and
>
> wherein the device further includes a spontaneous emission absorbing layer which is made of another nitride semiconductor of the first conductivity type and an energy cap as an absorbing spontaneous emission layer for emission from the active layer.

The Examiner stated that such changes were necessary to distinguish the claims 1-6 from the newly discovered reference to Hatano et al. (USP 5,998,810).

The Applicants' representative indicated to the Examiner that the suggested changes could not be agreed to without instructions from the Applicants and that a facsimile letter would be sent to the Applicants for permission to make those suggested changes, and, further, that every effort would be made to get a response to the Examiner's request promptly. On January 15, 2004, a facsimile letter was sent to the Applicants setting forth the above amendments and requesting instructions as follows:

> Please let us know if this amendment, or a similar amendment, is acceptable or whether you would prefer to receive an office action (which will most likely be a final action) elaborating the Examiner's position regarding the '810 patent.

That is, either agreeing to the Examiner's suggested amendment or a requesting an office action outlining the Examiner's position with regard to the relevance of the Hatano et al reference to the claims as presented in the Amendment of October 31, 2003.

On January 20, 2004, the Applicants' representative telephoned Examiner Flores Ruiz stating that no response had yet been received from the Applicants. On January 28, 2004, the Applicants' representative received a facsimile letter from the Applicants with the instruction:

> Please be advised that the amendment suggested by the Examiner is not acceptable and the Applicant wishes to wait for an Office Action to be issued.

That is, the Examiner's amendment is not acceptable, and to wait for an Office Action to be issued (presumedly containing some discussion of the Hatano et al. reference). Between January 29, 2004 and February 2, 2004, the Applicant's representative telephoned Examiner Flores Ruiz several times leaving several messages, and eventually spoke to the Examiner regarding the proposed Examiner's Amendment and the Applicants desire not to accept the Examiner's Amendment and instead receive an Office Action setting forth the Examiner's position with regard to the pending claims and the Hatano et al reference.

Examiner Flores Ruiz stated that the application was not currently with her and instead had been submitted for review and counting, but she would attempt to retrieve the application and discuss the matter with her Supervisor Mr. Ip. The Applicant's representative immediately called Mr. Ip, to reiterate the desire to not accept the Examiner's Amendment and to instead receive an Office Action setting forth the relevance of the Hatano et al. reference to claims 1-6. Mr. Ip stated that he was familiar with the application but would need to retrieve the application and review the file.

However, instead of withdrawing the Examiner's Amendment and Notice of Allowability, the Notice of Allowability/Examiner's Amendment was mailed on February 3, 2004. The Notice of Allowability was forwarded to the Applicants on February 9, 2004, and the Applicants sent another facsimile letter on February 24, 2004 again reiterating the desire not to accept the Examiner's Amendment. Mr. Massie telephoned Supervisor Ip, on February 24, 2004, to again express the Applicants desire not to accept the Examiner's Amendment. Mr. Ip apologized for the mistaken allowance and attributed the failure to receive the application due to the new image file wrapper creation process which scans all incoming and outgoing application papers. A copy of a proposed Amendment under Rule 1.312 was faxed to Mr. Ip that same day (if the allowance could not be withdrawn) and we reported the summary of the discussion with Mr. Ip to the Applicants in a facsimile letter on February 24, 2004.

On March 1, 2004, Mr. Massie again contacted Mr. Ip to express the Applicants' desire to have the allowance withdrawn and a new office action issued. Mr. Ip stated that the application was still in the initial data capture process in the Office of Publications, but would be retrieved when it became available. On April 12, 2004, Mr. Massie received a call from TC 2800 Customer Service representative, Ms. Stapor, who had retrieved the application from the Office of Publications. Upon contacting Mr. Ip by telephone on April 12, 2004, Mr. Massie was informed that the Mr. Ip had been re-assigned to Art Unit 2837 and was no longer the supervisor of Art Unit 2828. He stated Mr. Wong was now the

supervisor for Art Unit 2828, and that he would have the application sent to Mr. Wong and would send an message to Mr. Wong explaining the situation regarding the mistaken allowance of the application.

In light of these facts, it is respectfully requested that the Notice of Allowability of February 3, 2004 be withdrawn and a new Office Action be expeditiously prepared and mailed to the Applicants, since both Examiner Flores-Ruiz and Mr. Ip had indicated during numerous telephone conversations with the Applicant's representative, prior to and after mailing of the Notice of Allowability/ Examiner's Amendment on February 3, 2004, that the allowance of the application would be withdrawn and the application would receive a new office action setting forth the Examiner's position regarding the Hatano et al. reference.

The Applicants will provide to the USPTO a copy of each of the above referenced letters upon request, and, if necessary to the prompt issuance of the application, the Applicants agree to the cancellation of non-elected claims 7-30.

This request is made pursuant to the 37 C.F.R. 1.181 (no fee). However, if it is determined that in order to complete the consideration and granting of this request a fee is proper and necessary, the USPTO is authorized to charge the requisite fee to Deposit Account 19-2380 (740819-337)

Prompt consideration of this request is appreciated.

Respectfully submitted,

By: _____
Donald R. Studebaker
Reg. No. 32,815

DRS/JWM

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